

Serial No.: 10/053,456

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REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed February 27, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)**A. Rejection of Claims**

Claims 1, 2, 4-8, 10-17, and 19-25 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Ikeda et al.* ("Ikeda," U.S. Pat. No. 6,297,874) in view of *Parulski et al.* ("Parulski," U.S. Pat. No. 6,650,366). Claims 3, 9, and 18 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Ikeda* in view of *Parulski*, and further in view of *McKenna et al.* ("McKenna," U.S. Pat. No. 5,800,341). Applicant respectfully traverses these rejections.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, it is respectfully submitted that a *prima facie* case for obviousness has not been established.

Independent Claim 1

Claim 1 recites (with emphasis added):

1. An apparatus for capturing digital images, comprising:
an image sensor including a plurality of image capture elements,
each of the image capture elements configured to capture image data;
an input element for communicating print size information to the
apparatus; and
*means for determining which of the plurality of image capture
elements correspond to the print size.*

Assuming *arguendo* a proper combination, Applicant respectfully submits that *Ikeda* in view of *Parulski* does not disclose, teach, or suggest at least the above emphasized claim features. The Office Action provides as follows (page 3, section 4):

Parulski discloses means for determining which of the plurality of image capture elements correspond to the print size (see Figs. 4 and 5, column 2, lines 48-55, column 3 lines 51-61, column 4 lines 7-13, and column 4 line 63-column 5 line 38).

Applicant respectfully disagrees. Figures 4 and 5 of *Parulski* appear to illustrate various cropping mechanisms. As for the above cited-sections of *Parulski*, portions of one or more of the above-cited sections of *Parulski* are reproduced below:

[column 2, lines 48-52] A user selects at least one output image size different from the fixed image size, such that the output image will have a different number of picture elements than the fixed number of picture elements in the fixed size image.

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[column 4 lines 7-13] In operation, the CFA image data represents an image of a fixed size, usually an image substantially corresponding to the actual size of the image sensor 36. Consequently, the memory 50 stores the digital CFA image data from a fixed number of picture elements corresponding to this fixed image size.

[column 4 line 67-column 5 line 13] The user interface 67 provides user operated means for cropping the input image to an image size[sic]different from the fixed image size provided by the camera; in particular, the cropped image will have a different (e.g., smaller) number of picture elements than the fixed number of picture elements provided to the computer. (On the other hand, the output image, depending on the image size selected by the user, may have a larger number of pixels than the fixed number of picture elements provided to the computer.) The application programs then interpolate full color data for each picture element of the output image from the smaller number of picture elements and produce an interpolated output image having the selected output image size.

Applicant respectfully submits that the picture elements described in *Parulski* are not the same as the image capture elements described in claim 1. The picture elements of *Parulski* appear to refer to a sample or representation of a picture, such as in memory. For instance, referring to the above column 2 excerpt from *Parulski*, picture elements of the output image are described. The above column 4 (lines 7-13) excerpt also distinguishes the image sensor of *Parulski* from the image. Further, the column 4 section conveys that an image of a fixed size is "substantially corresponding to the actual size" of the image sensor. In other words, from this section, it appears that the full breadth of the sensor's elements (e.g., CCD array) is implemented and is fixed, and thus there is no need to determine which of the elements of the sensor's array in *Parulski* corresponds to a print size. The col. 4/5 excerpt provides that the "user interface 67 provides user operated means for cropping the input image to an image size[sic] different from the fixed image size provided by the camera; in particular, the cropped image will have a different (e.g., smaller) number of picture elements than the fixed number of picture elements," which again refers to the fact that, indeed, a cropped image will have fewer representations of the picture than the fixed image

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size. However, there is no reference in this section or the rest of *Parulski* to *determining which of the plurality of image capture elements correspond to the print size*. Further, *Ikeda* does not remedy this deficiency. Thus, Applicant respectfully requests that the rejection to independent claim 1 be withdrawn.

Because independent claim 1 is allowable over the proposed combination of *Parulski* and *Ikeda*, dependent claims 2-6 are allowable as a matter of law for at least the reason that the dependent claims 2-6 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

In addition to the above-described defects of the rejection, Applicant respectfully asserts that the proposed combination is improper. It has been well established that teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in that art the desirability of combining the teachings of *Ikeda*, which is directed to a film scanner, and *Parulski*, which is directed to a single sensor camera of the type that requires color filter array interpolation. Applicant respectfully submits that such a finding has not been established.

Independent Claim 7

Claim 7 recites (with emphasis added):

7. A method for adapting a print size to a captured image in a digital image capture device, the method comprising the steps of:
 - providing an image sensor including a plurality of image capture elements;
 - determining the elements of the image sensor that correspond to a selected print size;* and
 - presenting image sensor data corresponding to the selected print size to a user of the image capture device.

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For similar reasons presented in association with independent claim 1, Applicant respectfully submits that *Ikeda* in view of *Parulski*, assuming *arguendo* a proper combination, does not disclose, teach, or suggest at least the above emphasized claim features, and further that the proposed combination is improper. Accordingly, Applicant respectfully requests that the rejection to independent claim 7 be withdrawn.

Because independent claim 7 is allowable over the proposed combination of *Parulski* and *Ikeda*, dependent claims 8-15 are allowable as a matter of law.

Independent Claim 16

Claim 16 recites (with emphasis added):

16. A computer readable medium having a program for adapting a print size to a captured image in a digital image capture device, the program including logic for performing the steps of:

determining the elements of an image sensor that correspond to a selected print size; and

presenting image sensor data corresponding to the selected print size to a user of the image capture device.

For similar reasons presented in association with independent claim 1, Applicant respectfully submits that *Ikeda* in view of *Parulski*, assuming *arguendo* a proper combination, does not disclose, teach, or suggest at least the above emphasized claim features, and further that the proposed combination is improper. Accordingly, Applicant respectfully requests that the rejection to independent claim 16 be withdrawn.

Because independent claim 16 is allowable over the proposed combination of *Parulski* and *Ikeda*, dependent claims 17-24 are allowable as a matter of law.

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Independent Claim 25

Claim 25 recites (with emphasis added):

25. An apparatus, comprising:
a computer readable medium having a program for adapting a print size to a captured image in a digital image capture device by:
determining the elements of an image sensor that correspond to a selected print size; and
presenting image sensor data corresponding to the selected print size to a user of the image capture device.

For similar reasons presented in association with independent claim 1, Applicant respectfully submits that *Ikeda* in view of *Parulski*, assuming *arguendo* a proper combination, does not disclose, teach, or suggest at least the above emphasized claim features, and further that the proposed combination is improper. Accordingly, Applicant respectfully requests that the rejection to independent claim 25 be withdrawn.

Claims 3, 9, and 18

Assuming *arguendo* a proper combination, Applicant respectfully submits that *Ikeda* in view of *Parulski* fails to disclose, teach, or suggest at least the above-emphasized claim features of independent claims 1, 7, and 16 for similar reasons to those presented above. Further, Applicant respectfully submits that *McKenna* fails to remedy these deficiencies. Since claims 3, 9, and 18 incorporate the features of claims 1, 7, and 16, respectively, Applicant respectfully submits that a *prima facie* case for obviousness has not been established, and respectfully request that the rejections to claims 3, 9, and 18 be withdrawn.

In addition to the above-described defects of the rejection, Applicant respectfully assert that the proposed combination is improper. As explained above, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in that art the desirability of combining the teachings of *Ikeda*, which is

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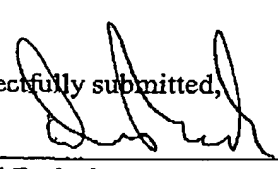
directed to a film scanner, *Parulski*, which is directed to a single sensor camera of the type that requires color filter array interpolation, and McKenna, which is directed to an electronically steerable endoscope. Applicant respectfully submits that such a finding has not been established.

In summary, it is Applicant's position that a *prima facie* for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that each of these claims is patentable over the art of record and that the rejection of these claims should be withdrawn.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


David Rodack
Registration No. 47,034

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